

## **Remarks**

### ***Interview***

A telephone interview was conducted with Examiner Comstock on January 7, 2009 during which the December 23, 2008 Office Action was discussed.

During the interview, it was suggested to the Examiner Comstock that the implants in Soboleski cited in the September 12, 2007 Office Action (implants 130 and 150 in Soboleski) are not configured for multi-direction articulation. As explained to Examiner Comstock, the implants 130 and 150 are configured with teeth that form a ratchet allowing the implants 130 and 150 to move with respect to one another only in one direction (Soboleski, paragraph 055). Examiner Comstock explained that he considered multi-direction articulation to be relatively broad and that he considered the implants of Soboleski to be capable of multi-direction articulation in different planes.

In light of Examiner Comstock's position on the claims, it was suggested that the claims would be allowable over Soboleski if they were amended to include the limitation that the articulating surfaces of the implants be smooth. Examiner Comstock indicated that he appreciated the difference between the claimed inventions and the cited prior art and further indicated that an amendment limiting the claims to implants with smooth articulating surfaces would likely overcome the rejection based on Soboleski. Examiner Comstock further cautioned that any amendment requiring smooth articulating surfaces should exclude implants having an articulating surface with both smooth and rough portions, as Examiner Comstock viewed Soboleski to disclose such implants.

### ***Claims***

Claims 1, 14, 20, 41, 47, 53, 60 and 61 have been amended. Claim 62 has been canceled. New claim 63 has been added. Claims 1, 14, 20, 41, 47 and 53 have been amended to include a smooth surface limitation as discussed during the January 7, 2009 interview. Claims 60-62 have been amended to correct dependency.

### **Rejections - 35 U.S.C. § 102(e)**

Claims 1-2,4-6,8-11,14-17,19-20,41-44,46-49,51-55,57-62 were rejected under 35 U.S.C. 102(e) as being anticipated by the Soboleski et al. (US Patent Publication Number 2002/0151895). As discussed during the January 7, 2009 interview, it is believed that the amended claims overcome the Examiner's rejection based upon Soboleski because Soboleski does not disclose implants having generally smooth surfaces that are capable of contacting and articulating with one another as required by the amended claims. Accordingly, it is respectfully submitted that claims 1-20 and 41-62 are in condition for allowance.

### **New Claim 63**

In addition, it is also respectfully submitted that new claim 63 is in condition for allowance. In the December 23, 2008 office action, the Examiner noted the following:

With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Soboleski et al., **which is capable of being used as claimed if one so desires to do so.** *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Offo*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

(Office Action, p. 3, emphasis added.)

The Examiner correctly acknowledges that in order to anticipate the claims of the present invention, one must consider whether a prior art reference discloses a device that is capable of being used in the manner claimed. Moreover, claim 63 includes the requirement that the translaminar fixation mechanism be "**adapted to** secure the inferior implant to the inferior articular facet by traversing a lamina connected to the inferior articular facet." (emphasis added). It is submitted that the "adapted to" clause imparts structural limitations. See MPEP 2111.04. It is also submitted that none of the references cited disclose the limitations of claim 63. Accordingly, it is respectfully submitted that claim 63 is in condition for allowance.

***Conclusion***

It is submitted that this application is in condition for allowance and an early action to that effect is earnestly solicited.

Respectfully submitted,

RENNER, OTTO, BOISSELLE & SKLAR, LLP

By /Mark C. Johnson/  
Mark C. Johnson, Reg. No. 51,854

1621 Euclid Avenue  
Nineteenth Floor  
Cleveland, Ohio 44115  
(216) 621-1113

M:\H\HORA\IP0101US\Application\HORA.P0101US.R06.doc